

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 25, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1-7, 11, and 13 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Garfinkle (U.S. Pat. No. 6,924,878). Applicant respectfully traverses this rejection.

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Garfinkle reference. Applicant discusses the Garfinkle reference and Applicant’s claims in the following.

A. The Garfinkle Disclosure

Garfinkle discloses a method of processing a roll of exposed photographic film. Garfinkle, Patent Title. In the method, photographic film is sent to a developer 12 where the photographic film is developed and scanned to acquire digital images of the captured film images. Garfinkle, column 3, lines 45-51. The digital images are then stored on an

image server 16. Garfinkle, column 3, line 50. The photographer that captured the film images can then access the digital images using a browser and request various tasks, such as printing the images. Garfinkle, column 6, lines 1-20.

B. Applicant's Claims

Applicant's claim 1 provides as follows (emphasis added):

1. A method for facilitating pay printing, the method comprising:

a network-based printing service retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network;

the printing service receiving print option selections; and

the printing service determining printing costs for printing the full-size document based upon attributes of the scaled-down version.

Regarding the Garfinkle disclosure, Garfinkle clearly does not teach a network-based printing service "retrieving a scaled-down version of a full-sized document to be printed from at least one store via a network" or the printing service "determining printing costs for printing the full-size document based upon attributes of the scaled-down version". First, Garfinkle says nothing about a printing service retrieving any scaled-down version of a document. Second, Garfinkle says nothing about determining printing costs of the document based upon that scaled-down version. Applicant notes that column 6, lines 1-20 of the Garfinkle reference merely teaches showing digital images of pictures captured with a film camera to the photographer and permitting the photographer to order prints "in a

variety of formats and sizes”. No scaled-down version of an image is “retrieved” by a printing service, or used to determine printing costs.

In view of at least the foregoing, it is clear that Garfinkle does not anticipate claim 1, or the claims that depend from claim 1. Accordingly, Applicant requests that the rejection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claim 12 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Garfinkle in view of Official Notice. Applicant respectfully traverses this rejection.

As is identified above, Garfinkle does not teach several aspects of Applicant’s claim 1. Applicant therefore submits that claim 12, which depend from claim 1, is allowable over the Garfinkle for at least the same reasons that claim 1 is allowable over Garfinkle.

Regarding the Examiner’s use of “official notice,” the Manual of Patent Examining Procedure (MPEP) defines the standard for taking official notice. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088,

1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner’s assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

In the instant case, Applicant asserts that a printing service of the type recited in claim 1 being supported by “an embedded server” of a “printing device” was not “well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known”. Specifically, printers with embedded servers were not well known in 2001 when the application was filed. Indeed, it can be said that such printers were generally unknown, or known to only few persons, at that time. Accordingly, Applicant traverses the Examiner’s use of official notice. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the official notice determination. Presumably, it will be easy for the Examiner to identify such evidence if, in fact, printing devices that support network-based printing services with embedded servers were “well-known” at the time the application was filed.

III. Canceled Claims

Claims 5 and 6 have been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

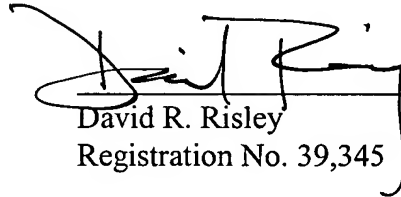
IV. New Claim

Claim 30 has been added into the application through this Response. Applicant respectfully submits that that new claim describes an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that the claim be held to be allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

11-14-05
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Signature